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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,508	08/05/2003	Walter Thomas Bray JR.	8530.585USI1	6907
23552	7590	09/07/2004	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			MOHANDESI, JILA M	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 09/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/634,508

**Applicant(s)**

BRAY ET AL.

**Examiner**

Jila M Mohandesi

**Art Unit**

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 26-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>07-06-2004</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election without traverse of invention II in the reply filed on June 21, 2004 is acknowledged.

***Claim Objections***

2. Claims 27-28 and 30-50 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Applicant is claiming the method of manufacturing a slipper. Since independent claim 26 only contains one active positive step in the method, applicant has failed to provide any active positive steps in the dependent claims that would further limit the method steps of claim 26.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 26 - 43 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bray, Jr. et al. (6,226,894) in view of Snyder 232 and Patterson et al. (6,176,025). Bray '894 discloses a method of placing an insole within the insole receiving area of a slipper, the insole comprising: an outsole (12) having a top outsole

side, a bottom outsole side, and an outsole retaining wall extending along a circumference of the outsole; an upper (vamp 106) having an outsole attachment area (perimeter 136), a foot covering area (102), and a stabilizing member (sock 109, see Figure 35 embodiment), wherein: the stabilizing member is attached along the outsole attachment area to provide an insole receiving area between the stabilizing member and the foot covering area; and the outsole attachment area is attached to the outsole retaining wall; and an insole (104) for placing inside an insole receiving area of a footwear comprising: a foam layer (110) having a first foam side and a second foam side and a fabric layer, the insole comprising: a heel region (114) having a heel cushioning portion and a heel perimeter portion, and arch region having an arch cushioning portion and an arch perimeter portion, and a toe region having a toe cushioning portion and a toe perimeter portion. See Figures 28 and 35 embodiments. Bray '894 does not appear to disclose the insole having a heel perimeter portion comprising a retaining wall that extends above the top surface of the heel cushioning portion and a arch perimeter portion comprising an arch support that extends above the top surface of the arch cushioning portion and for the heel cushioning portion to include low and high density foam area. Snyder '232 discloses an insole comprising: a heel region (14) having a heel cushioning portion and a heel perimeter portion, wherein the heel perimeter portion comprises a retaining wall that extends above the top surface of the heel cushioning portion; and arch region (16) having an arch cushioning portion and an arch perimeter portion, wherein the arch perimeter portion comprises an arch support that extends above the top surface of the arch cushioning portion; and a toe

region to better hold and secure the foot of the wearer. Patterson '025 discloses an insole wherein the heel cushioning portion includes a first higher density foam area (lower layer 20) and a first lower density foam area (cushioning element 40) forming a cushioning area that cups the heel. See Figure 10 and column 3, lines 41-49. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the insole of Bray '894 with a heel perimeter portion comprising a retaining wall that extends above the top surface of the heel cushioning portion and a arch perimeter portion comprising an arch support that extends above the top surface of the arch cushioning portion as taught by Snyder '232 to provide better hold and secure the foot of the wearer. It also would have been obvious to one of ordinary skill in the art at the time the invention was made to provide low and high density foam in the heel cushioning portion of Bray '894 as taught by Patterson '025 to provide a better cushioning area that cups the heel.

With respect to claim 29, official notice is taken that it is old and conventional to adhere insoles within insole receiving area of a footwear to better secure the insole in the footwear.

With respect to claims 30-32 and 42-43 and the height of the lower density area and the higher density area and the height of the retaining wall, it would have been an obvious matter of design choice to modify the height of the lower density area and the higher density area and the height of the retaining wall since such a modification would have involved a mere change in the size of a component. A change in size is generally

recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

With respect to claim 34, see Figure 3 embodiment and column 4, lines 28-33.

With respect to claim 37 and the shape of the heel cushioning portion see Figures 2 and 3 embodiments.

5. Claims 44-46 and 48-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over the above references as applied to claim 26 above, and further in view of Kukoff '941. Bray '894 as modified above discloses all the limitations of the claims except for perforations in the heel arch and toe region of the insole. Kukoff '941 discloses an insole with perforations in the heel, arch and toe regions of the insole to assist in air circulation and increase flexibility. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide perforations in the heel, arch, and toes regions of the insole of Bray '894 to assist in ventilation of the insole.

### ***Conclusion***


6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shown are insoles analogous to applicant's invention.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M Mohandesi whose telephone number is (703) 305-7015. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (703) 308-2672. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**JILA M. MOHANDESI  
PRIMARY EXAMINER**

  
Jila M Mohandesi  
Primary Examiner  
Art Unit 3728

JMM  
May 25, 2004